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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,835	08/30/2001	Vladimir Jovancevic	194-26872-US	3322

24923 7590 07/06/2004  
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HOUSTON, TX 77057-1130

EXAMINER
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METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/944,835

**Applicant(s)**

JOVANCICEVIC ET AL.

**Examiner**

Daniel S. Metzmaier

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2002 & 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/3/02 &amp; 10/7/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-20 are pending.

#### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: applicants should clarify the structures (V) and (VI) (page 4) regarding the group -C(=O)-RO. To the extent said group is to represent an ester group, it should be denoted -C(=O)-OR.

Appropriate correction is required.

#### ***Claim Objections***

3. Claims 1-20 are objected to because of the following informalities: applicants should clarify the structures (V) and (VI) (claims 3, 7, 13 and 17) regarding the group -C(=O)-RO. To the extent said group is to represent an ester group, it should be

denoted  $-C(=O)-OR$ . The remaining claims are included herein to the extent the wholly incorporate said limitations. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 19 and 20 references the method of claim 17 but independent claim 17 is directed to a composition rather than a method and lacks a method step. It is unclear what metes and bounds of the claimed subject matter applicants intend.

***Claim interpretation***

6. Applicants' claims 1-10 are directed to a method of reducing drag of a fluid by employing the active steps of "providing a fluid" and "adding . . . an additive effective to reduce drag". Said fluid is defined in claims 2, 7-10, 12, and 17-20 as selected from the group consisting of hydrocarbons, mixtures of hydrocarbons and water, and mixtures of hydrocarbons, water and gas. Claims 5 and 9 define the claimed effective amount as 100 to 1000 ppm. The specification (paragraph [0022]) specifies said range as well as preferred ranges of 150 to 600 ppm and 200 to 500 ppm.

Claims 6, 10, 16 and 20 set forth, "the additive contains more than one maleated fatty acid, ester and salt thereof". This is interpreted as a mixture of two or more different compounds differing in molecular structure, e.g., isomers, acid, ester, salt.

Natural fatty acid sources such as tall oil include mixtures and maleated fatty acids resulting therefrom would also be expected to produce mixtures of more than one maleated fatty acid, ester and salt thereof.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kindscher et al, US 3,985,504. Kindscher et al (abstract; column 2, lines 39-63 ; examples and claims) discloses adding maleated tall oil fatty acids neutralized with triethanolamine (tertiary amine) and is added to a fluid in an amount (claim 1) of 0.5 to 5% by weight (equates to 500 to 5000 ppm) of said fluid. The drag reducing function and an amount of the additive effective to reduce drag would have been inherent to the methods and compositions of Kindscher et al since the methods and compositions read on and are otherwise anticipate the additive, method steps and concentrations for use as a corrosion inhibitor.

9. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dougherty et al, 5,582,792. Dougherty et al (abstract; column 2, lines 39-63 ; examples and claims) discloses adding maleated fatty acids neutralized with diethoxylated alkyl amine (tertiary amine) and is added to a fluid in an amount (example2 and claims 1 and 6) of 25 to 1000 ppm of said fluid. The drag reducing function and an amount of the

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additive effective to reduce drag would have been inherent to the methods and compositions of Dougherty et al since the methods and compositions read on and are otherwise anticipate the additive, method steps and concentrations for use as a corrosion inhibitor.

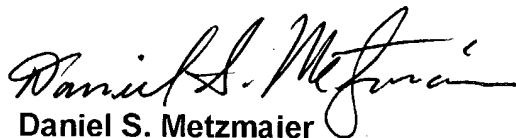
### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Daniel S. Metzmaier**  
**Primary Examiner**  
**Art Unit 1712**

DSM